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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/815,592	03/12/97	MARUTA	M 1422-0297P

IM81/0409
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EXAMINER

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ART UNIT	PAPER NUMBER
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1714

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DATE MAILED: 04/09/99

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GROUP 1700

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 17

Application Number: 08/815,592
Filing Date: March 12, 1997
Appellant(s): Masayuki Marutai et al.

C. Joseph Faraci
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed on March 1, 1999.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

This appeal involves claims 2-7, 22-35 and 37.

Claims 9-21 are withdrawn from consideration as not directed to the elected invention.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

The amendment after final rejection filed on November 30, 1998 has been entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 2-7, 22-35 and 37 do not stand or fall together and provides reasons in section (8) arguments as set forth in 37 CFR 1.192(c)(7) and (c)(8).

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(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

Millar et al.	3,860,557	1-1975
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(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-7, 22-35 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Millar et al.

The main issue here is dependent on how to interpret the teaching of Millar at col. 4, lines 11-15. Obviously, appellant and the examiner have different views as evidenced by previous Office actions and appellant's response.

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Millar teaches a powder coating composition comprising a mixture of discrete polymeric powders for an electrostatic coating in claim 1. Millar also teaches a powder coating composition comprising at least two different powders having quite similar dielectric constants and quite similar specific gravities at col. 4, lines 11-15. The examiner's interpretation of the said lines 11-15 is that it is a mixture of discrete polymeric powders (each powder comprising a single polymer rather than each powder comprising a mixture (homogeneous blend) of at least two polymers) in view of the claim 1 wherein each powder comprising a single polymer is taught. Besides, if each powder were comprised of a mixture (homogeneous blend) of at least two polymers, and then said powder would have the same dielectric constants and the same specific gravities, not quite similar properties.

Note that the instant invention and that of Millar are directed to the same application, an electrostatic coating of polymeric powders. Thus, even though Millar does not specify particular values, said quite similar dielectric constants taught by Millar substantially meets the instantly recited various electrical properties such as triboelectric charge, dielectric constant and ratios of electric resistance. Also, said quite similar specific gravities substantially meets the instantly recited various physical properties such as true specific gravities, apparent densities and softening points. The instant particle sizes are taught at col. 5, lines 3-19.

Millar teaches powders having various colors such as black (examples I), white (example III) or clear (example VII). A coated substrate having a homogeneous coating of at least two different color powder coatings inherently exhibit a homogeneous hue.

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It would have been obvious to one of ordinary skill in the art at the time of the instant invention to utilize color powder coatings comprising a mixture of discrete polymeric powders (each powder comprising a single polymer) having a colorant or pigment therein in Millar since Millar teaches a powder coating composition comprising at least two different powders having quite similar dielectric constants and quite similar specific gravities and the use of various colorants therein. Choosing different color powder coatings to obtain the desired final color (white + black = gray or red + yellow = orange) is a routine practice in the paint art since a manufacture of every known colors in a factory is uneconomical (process, transporation and stroage) and since the mixing of different colors to yield the desired color is well known and can be seen any Home Improvement stores such as Sears or Home Depot.

Note that the anticipation rejection under 35 U.S.C. 102(b) has been withdrawn.

(11) Response to Argument

(A) ISSUE 1

No further response by the examiner is deemed necessary since the anticipation rejection has been withdrawn. However, pertinent arguments will be given considerations in following section **(B)**.

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(B) ISSUE 2

Group I - Claims 22, 25 and 26

Appellants' assertion on a multi-layered structure of Millar has no probative value since the instant invention is directed to a coating composition, not a single-layer coated substrate. Thus, even if appellant's assertion has any probative value, the teaching of one final layer (col. 4, line12) on any substrate having any coating thereon rebuts appellant's assertion since a particular substrate is not required in the instant invention. Even though Millar's main invention is directed to a multi-layered coating, the teaching on col. 4, lines 11-15 cannot be ignored. See *In re Mills*, 477 F2d 649, 176 USPQ (CCPA); Reference must be considered for all that it discloses and must not be limited to its preferred embodiments or working examples.

As pointed out in the above rejection, the instant invention and that of Millar are directed to the same principle, an electrostatic coating, and thus the teaching of quite similar dielectric constants substantially meets the invention. Appellant's argument on 'components', "powder" and "materials" of Millar is appellant's interpretation, and the examiner has interpreted otherwise as reason given above and the previous Office actions.

Group II - Claim 37

Choosing different color powder coatings to obtain the desired final color (white + black = gray or red + yellow = orange) is a routine practice in the paint art since a

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manufacture of every known colors in a factory is uneconomical (process, transporation and stroage) and since the mixing of different colors to yield the desired color is well known and can be seen any Home Improvement stores such as Sears or Home Depot.

Group III - Claims 2 and 27

Millar teaches quite similar specific gravities in an electrostatic coating application, and thus choosing the recited true speicific gravity is a *prima facie* since a large difference in said true speicific gravity would not yield a homogeneous coating.

Group IV - Claims 3 and 28

Millar teaches quite similar specific gravities in an electrostatic coating application, and thus choosing the recited apparent densities is a *prima facie* since a large difference in said apparent densities would not yield a homogeneous coating.

Group V - Claims 4 and 29

Millar teaches quite similar dielectric constants and quite similar specific gravities in an electrostatic coating application, which requires similar polymeric properties inherently. Thus choosing polymers having a similar or the recited difference in softening point (Tg) is a *prima facie* since a large difference in said Tg would not yield a homogeneous coating due to different degrees of softening or melting of polymers. Note that polymers must be fused

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and/or crosslinked together to form a homogeneous coating which needs the same or similar Tgs and/or melting points.

Group VI - Claims 5 and 30

Millar teaches quite similar dielectric constants in an electrostatic coating application, and thus choosing the recited dielectric constants is a *prima facie* since a large difference in said dielectric constants would not yield a homogeneous coating in an electrostatic coating application.

Group VII - Claims 6 and 31

Millar teaches quite similar dielectric constants in an electrostatic coating application, and thus choosing the recited ratios of electric resistance is a *prima facie* since a large difference in said ratios would not yield a homogeneous coating in an electrostatic coating application. Note that said electric resistance is directly related to said dielectric constants.

Group VIII - Claims 23 and 24

Choosing powders having the same or a similar average particle size in an electrostatic coating application is a *prima facie* since a large difference in said size would not yield a homogeneous coating in an electrostatic coating application and since Millar teaches said sizes.

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Group IX- Claims 24 and 35

Millar teaches that the most preferred average particle size is about 35 microns for electrostatic spraying application at col. 5, lines 12-14, and thus choosing about 35 microns is *a prima facie*.

Group X- Claims 7 and 33

Example III of Millar teaches a white pigment, titanium dioxide, and the instantly recited “the remaining powder coating do not contain a white powder” encompasses other colored pigment. Thus, choosing different color powder coatings to obtain the desired final color (white + black = gray or red + yellow = orange) is a routine practice in the paint art since a manufacture of every known colors in a factory is uneconomical (process, transporation and stroage) and since the mixing of different colors to yield the desired color is well known and can be seen any Home Improvement stores such as Sears or Home Depot.

Group XI- Claim 32

The examiner has rebutted appellant’s arguments as to claims 26-31, and thus choosing any one of claims 26-31 is a *prima facie*.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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PRIMARY EXAMINER
GROUP 1500

THY
April 8, 1999

Approved
JTB

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